



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,686	03/14/2000	David J. Luneau	1090-006	1741

26161 7590 05/30/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

NGUYEN, LEE

ART UNIT	PAPER NUMBER
----------	--------------

2682

DATE MAILED: 05/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

10

Office Action Summary

Application No.

10/042,686

Applicant(s)

LUNEAU, DAVID J.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed 3/24/2003.

Double Patenting

2. Applicant will file a terminal disclaimer upon receipt of a notice of allowability as shown in the remarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 18-20, 26-30, 34-36, 42-44, 47-50, 52-55, 57-60, 62-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Lim (US 5,265,145) submitted by Applicant.

Regarding claim 18, Lim teaches a caller announcement apparatus (fig. 1) for a telephone system that provisions a telephone call

between a caller telephone at a caller station and a called telephone at a called station, where the caller station is associated with an identity (col. 3, line 7), where the telephone system provides signals to the called station that include caller identification signals representative of the identity associated with the caller station (number/name) and voice signals representative of audio detected by an audio transducer of the caller telephone, and where the voice signals are processed by the called telephone to produce audio using an audio transducer at the called station (inherently when the called station answers the calling station), the caller announcement apparatus comprising:

a signal receiver 5, 6 at the called station operatively connected to the telephone system to receive signals therefrom, the signal receiver being operative to extract caller identification signals from the signals received from the telephone system and to provide caller identification data corresponding to the extracted caller identification signals (col. 2, line 34);

a processing unit 8 operatively connected to the signal receiver to receive caller identification data therefrom, the processing unit being

operative to provide identity information associated with the caller identification data (col. 2, line 35-41);

an audio announcing circuit 13 operatively connected to the processing unit to receive identity information therefrom, the audio announcing circuit being operative to use the identity information to produce audio using the audio transducer at the called station (col. 2, lines 41-45).

Regarding claims 42, 57, 62-63, the method claims are interpreted and rejected for the same reason as set forth in the apparatus claim 18.

Regarding claim 52, the claim is interpreted and rejected for the same reason as set forth in claim 18. Lim also teaches audio transducer 15 (fig. 1).

Regarding claims 19, 43, 55, 60, Lim also teaches the processing unit comprises memory storage (RAM, fig. 1) for storing identity information associated with the caller identification data.

Regarding claims 20, 44, Lim also teaches that the processing unit upon receiving caller identification data extracts from the memory

storage the identity information associated with the caller identification data (col. 3, line 16).

Regarding claims 26-28, 47-49, Lim further teaches that the caller identification data includes a telephone number and name associated with the caller station (col. 3, line 8).

Regarding claims 29-30, 59, Lim also teaches that the audio information corresponding to the name associated with the caller station is recorded audio information recorded by the user (col. 2, lines 44, 57-58).

Regarding claim 34, Lim further teaches that the identity information associated with the caller identification data is information corresponding to a telephone number associated with the caller station (col. 3, line 7).

Regarding claim 35, Lim further teaches that the audio announcing circuit includes a speech synthesizing circuit to produce synthesized speech of the telephone number associated with the caller station using the audio transducer at the called station (col. 2, line 44).

Regarding claim 36, Lim further teaches that the apparatus is a part of the called telephone (fig. 1).

Regarding claims 53, 58, Lim also teaches that the telephone includes the transducer 15 (fig. 1).

Regarding claims 54, 59, the claims are interpreted and rejected for the same reason as set forth in claim 18.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21, 31-33, 51, 56, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Figa et al. (US 4,924,496).

Regarding claim 21, Lim also teaches that that the identity can be added (col. 4, lines 3-7). Lim fails to teach the conventional deletion and edition of data. Figa teaches that data can be deleted and edited as shown in figures 9-10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Figa to the apparatus of Lim in order to provide the user with data entry options.

Regarding claims 31-33, 51, 56, 61, Lim does not explicitly teach that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station. Figa teaches that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station (fig. 2, numeral 34, area code 617). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Figa to the apparatus of Lim in order to provide the user with the area code of the caller.

7. Claims 22-25, 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Blakley (US 4,899,358).

Regarding claims 22-25, 45-46, Lim fails to teach an isolation circuit operative to prevent the telephone system from completing the telephone call from the caller telephone to the called telephone while the audio announcement circuit is producing audio using the audio transducer at the called station or operative to prevent the telephone

system from recognizing that the telephone at the called station is off hook while the audio announcement circuit is producing audio using the audio transducer at the called station or operative to cause the telephone system to complete the telephone call from the caller telephone to the called telephone in response to an input from a party at the called station, or to operative to cause the telephone system to recognize that the called telephone is off hook in response to an input from the party at the called station. However, Blakley specifically teaches in col. 1, lines 64-67 that "the name is spoken after the called party has answered in response to ringing at the station but before a connection is completed to the caller". When providing the audible announcement concept of Blakley in a local environment, as in ^{Lim} ~~Eiga~~, it would have been obvious to one of ordinary skill in the art to isolate the telephone apparatus from the telephone system in order that the caller's identity is audibly announced through the handset without the caller being aware that the user has gone "off-hook" with the telephone, and thus preventing a direct connection between the caller and called person. In addition, connecting the telephone apparatus to the telephone system after the user decides to accept the call (i.e. the

connection means) is inherent in order to establish a communication link between the caller and called person.

8. Claims 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim.

Regarding claims 37-41, although Lim teaches to associate their caller ID concept with a standard telephone set, it is well known in the art to associate caller ID capability with other telephonic devices (i.e cordless telephones, facsimiles, etc.) and would have been obvious to incorporate with other telephonic devices lacking any criticality or showing by applicant.

Response to Arguments

9. Applicant's arguments with respect to claims 18-63 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE**

FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone numbers for the organization where this application or

Application/Control Number: 10/042,686
Art Unit: 2682

Page 11

proceeding is assigned are (703) 872-9314 for regular communications and
(703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this
application or proceeding should be directed to the receptionist whose
telephone number is 703-305-4700.

LEE NGUYEN *lee* 5/24/03
Primary Examiner
Art Unit 2682